

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited references, combined, teach or suggest each of the elements of a claim. Further, there must be some suggestion or motivation either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the reference teachings. See MPEP § 2143. In regard to claims 35, 38, 44, 47 and 56, these claims include the elements of user input initiating a transmission mode. The Examiner admits in Paper No. 14 that Nishiyama fails to disclose that the auto response is triggered by user input that transitions the phone into a transmission mode. The Examiner seeks to modify Nishiyama based on Christal, which requires user input before a predetermined message can be sent. However, Nishiyama teaches away from such combination. Rather, Nishiyama teaches generating an “automatic” response based on the source of an incoming call using the telephone number of the incoming call to identify the source. See Abstract, Nishiyama. Nishiyama explicitly states that it is an object of its invention to “provide a radio telephone system in which plural response messages are stored in a telephone set for a callee who may be absent at a time of receiving a call.” See Nishiyama, col. 1, lines 51-55. Nishiyama involves a system of precategorizing incoming telephone numbers and associating them with predetermined responses so as to eliminate the need for human intervention in the response process. Thus, one of ordinary skill in the art would not think to modify Nishiyama to require user intervention in the transmission process.

Further, the examiner has not identified and Applicants have been unable to discern any part of Nishiyama or Christal that teaches the desirability of allowing a user to have more intervention in the transmission process. As mentioned above, Nishiyama teaches away from such an assertion. Applicants respectfully request that the Examiner identify the part of the cited references that teaches the desirability of requiring user intervention. If the Examiner believes that this is knowledge generally available to one of ordinary skill in the art, Applicants respectfully request the Examiner substantiate such an assertion. Thus, Nishiyama teaches away from Examiner’s proposed motivation for combining Nishiyama with Christal.

In regard to claims 35 and 44, these claims also include the elements of receiving previously requested data. The Examiner has not indicated and Applicants have been unable to discern any part of the cited references that teach or suggest the reception of previously requested data as claimed in claims 35 and 44. Rather, both Nishiyama and Christal teach a system that receives unrequested incoming communication such as an incoming call. See Nishiyama, col. 1, line 45 to col. 2, line 19 and Christal, col. 1, lines 33-63. Thus, Nishiyama and Christal do not teach these elements of claims 35 and 44.

In regard to claims 35, 44 and 47, these claims include the elements of automatically selecting a form for a message to be transmitted by the user based on content of the displayed information at the time the user input is received. Nishiyama does not teach this element of claims 35, 44 and 47. The Examiner asserts in Section 4 of Paper No. 14 that Nishiyama teaches a “formatted response message which is automatically transmitted to a caller (col. 3, lines 19-60).” However, these actions are not equivalent to selecting a form based on displayed content. The response messages taught by Nishiyama are complete messages that are automatically transmitted to a caller. See col. 3, lines 46-60, Nishiyama. Whereas a form is a “document with blanks for the insertion of details or information.” See *The American Heritage Dictionary of the English Language*, Fourth Edition, 2000, Houghton Mifflin. Thus, the completed messages of Nishiyama are not forms.

Christal does not cure the defects of Nishiyama. Christal teaches a device that provides two options for responding to SMS messages. The first option for responding to SMS messages taught by Christal is sending back a preset “YES” message when viewing a message by pressing sequentially an “OPTION” button, a “YES” button, and finally a “SEND” button to send the message. See Christal, col. 2, lines 29-34 and Figure 4. A second option while viewing received messages is to press the “OPTION” button and then to press an “EDIT” button which opens an editor that allows the creation of return message using a key pad and then the message can be sent by pressing the “SEND” button. See Christal, col. 2, lines 34-47. Neither of these two manners of responding to a message taught by Christal involve the automatic selection of a form for a

message to be transmitted based on the content of a displayed information at a time that the transmission mode was initiated by user input. All of the contents of the messages generated for the reply taught by Christal are a result of direct user selection (i.e., sending a "YES" message by pressing a sequence of buttons or composing a message on a key pad." Thus, Christal does not teach an automated selection of a form based on the content of displayed information. Therefore, Nishiyama combined with Christal does not teach these elements of claims 35, 44 and 47.

For the reasons detailed above, Nishiyama cannot be properly combined with Christal to teach each of the elements of claims 35, 38, 44, 47 and 46. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for these claims. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 35, 38, 44, 47 and 56 are requested.

In regard to independent claim 53, this claim includes the elements of automatically entering a transmission mode for allowing a user to transmit an electronic mail message from the telephone. For the reasons mentioned above in regard to claims 35, 38, 44, 47 and 56, namely that Nishiyama cannot be combined with Christal that teach initiating a transmission mode based upon user input, Nishiyama cannot be combined with Christal in order to teach the elements of claim 53. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 53. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 53 are requested.

In regard to claims 36, 37, 39-43, 45, 46, 48, 49, 54 and 55, these claims depend from independent claims 35, 38, 44, 47, 53 and 56 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to these independent claims, the dependent claims are not obvious over Nishiyama in view of Christal. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

II. Double Patenting Rejection

Claims 35-49 and 53-56 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,196,911 issued to Wagner, et al., (hereinafter "Wagner '911").

Submitted herewith is a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c).
Accordingly, reconsideration and withdrawal of the double patenting rejection are requested.

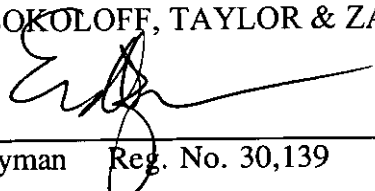
CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 35-49 and 53-56 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

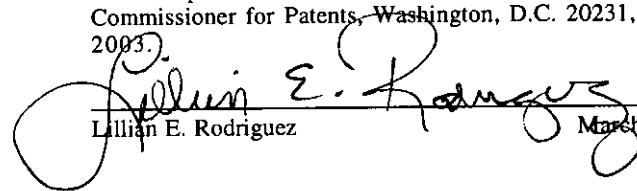
Dated: 3/27, 2003


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Box Non-Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231, on March 27, 2003.


Lillian E. Rodriguez

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